REMARKS

In the Office Action dated May 4, 2005, claims 22, 29, 30, 31, and 38 were rejected under 35 U.S.C. § 102 over U.S. Patent No. 6,628,644 (Nelson); claims 2, 3, 13, and 33 were rejected under § 103 over Nelson in view of U.S. Patent No. 6,091,808 (Wood); claims 4, 6, and 19 were rejected under § 103 over Nelson in view of "(if applicable) Wood" and further in view of U.S. Patent No. 6,310,873 (Rainis); claims 14, 20, 21, 23, 26, 28, 35-37, 39, 41, and 42 were rejected under § 103 over Nelson in view of "(if applicable) Wood" or "(if applicable) Rainis" and further in view of U.S. Patent No. 6,553,515 (Gross); claims 15-17 were rejected under § 103 over Nelson in view of Gross and U.S. Patent No. 6,134,319 (Burg); claims 8-12, 23, and 25 were rejected under § 103 over Nelson in view of "(if applicable) Wood" or "(if applicable) Gross" and further in view of U.S. Patent No. 6,453,034 (Donovan); claim 32 was rejected under § 103 over Nelson and U.S. Patent No. 6,360,254 (Linden); and claim 40 was rejected under § 103 over Nelson in view of Donovan and Gross.[1]

Applicant acknowledges the indication that claim 18 is allowed, and the indication that claim 5 contains allowable subject matter.

Independent claim 33 was rejected as being obvious over Nelson and Wood. 5/4/2005 Office Action at 5. It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 33 over Nelson and Wood for at least the following two reasons: (1) no motivation or suggestion existed to combine Nelson and Wood; and (2) even if combined, the hypothetical combination of Nelson and Wood does not teach or suggest all elements. *See* M.P.E.P. § 2143 (8th ed., Rev. 2), at 2100-129.

As conceded by the Office Action, Nelson fails to disclose a terminal that performs both sending the call request and communicating voice data as recited in claim 33. 5/4/2005 Office Action at 7. However, the Office Action relied upon Wood as teaching the claimed elements missing from Nelson. *Id.* The obviousness rejection is defective for the reasons given below.

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[1] Several of the obviousness rejections cited "(if applicable)" references. Such a citation is improper, since a reference is either applicable or it is not with respect to any claim. Also, the indication of "(if applicable)" renders the rejections confusing and difficult to determine what references are applied against which claims. Therefore, if such rejections are re-raised in the next Office Action, Applicant respectfully requests that the identification of references against each particular claim be more explicit.

In Fig. 1 of Nelson, neither the IP phone 22a nor the computer 24 performs the acts recited to be performed by the terminal of claim 33. The IP phone 22a of Nelson does not display a hyperlink, receive an indication of user selection of the hyperlink, and generate a call request for establishing a call session over a packet-based network based on the indication of user selection of the hyperlink. The computer 24 is able to display the browser 100 of Fig. 3 of Nelson—however, the computer 24 of Nelson does not communicate voice data over an Internet Protocol (IP) network.

Recognizing this deficiency of Nelson, the Office Action relied upon Wood as disclosing the subject matter not taught by Nelson. However, Wood does not disclose communicating voice data over an IP network, which is an express element of claim 33. The Office Action stated that "Wood (similarly to Nelson) discloses a similar device capable of participating in call session over a packet-based data network ...." 5/4/2005 Office Action at 7. Note, however, that the telephone switch 16 depicted in Figure 1 of Wood is a "central office (C.O.) forming part of the public switched telephone network (PSTN), or a PBX or telephone key system which is coupled to the PSTN in a known matter." Wood, 3:28-32. A telephone 10 is connected by either a twisted wire pair (path 14) or another circuit-switched link such as ISDN. Wood, 3:33-44. There is absolutely *no* teaching or suggestion that the telephone switch 16 of Wood is capable of establishing a call session over an IP network. In fact, the opposite is taught by Wood, in which the telephone switch 16 is a PSTN central office or a PBX or a telephone key system coupled to the PSTN. In other words, the telephone switch 16 communicates voice data over a circuit-switched network (PSTN), *not* over an IP network as recited in claim 33.

Therefore, even if Nelson and Wood can be properly combined, the hypothetical combination of Nelson and Wood does not teach or suggest *all* elements of claim 33, namely the element of a terminal that can communicate voice data over an IP network, which terminal also performs the other tasks of claim 33. For at least this reason, a *prima facie* case of obviousness has not been established over Nelson and Wood.

There also did not exist any motivation or suggestion to combine the teachings of Nelson and Wood. The Office Action stated that the suggestion or motivation to combine the teachings of Nelson and Wood was to "reduce the cost of manufacture by integrating the functions into one terminal" and increasing "user-friendliness." 5/4/2005 Office Action at 7. The Office Action

cited to the teaching in Wood that the functions of the web browser 12 and telephone 10 can be integrated into a single unit. *Id.* However, these considerations still do not address the fundamental issue that the telephone switch 16 of Wood is a circuit-switched telephone switch for communicating over a PSTN. There is no motivation to substitute the telephone switch 16 of Wood (for communicating circuit-switched voice) for either the telephone 22a or personal computer 24 of Nelson. Doing so would defeat the purpose of communicating over an IP network as taught in Fig. 1 of Nelson, since the circuit-switched central office switch 16 of Wood would be unable to communicate over the IP network of Nelson. In other words, incorporating the telephone switch 16 of Wood into the IP network of Nelson would defeat the intended purpose of Nelson, namely to communicate over an IP network. Therefore, this is an indication that no motivation or suggestion existed to combine the teachings of Nelson and Wood.

In view of the foregoing, a *prima facie* case of obviousness has not been established with respect to claim 33.

Independent claim 22 was rejected as being anticipated by Nelson. 5/4/2005 Office Action at 3. Amended claim 22 recites a device that includes a display, a hyperlink presentable in the display, and a controller to generate a Session Initiation Protocol (SIP) call request in response to selection of the hyperlink, where the SIP call request is for establishing a call session over the data network. Claim 22 further recites that the hyperlink is associated with a uniform resource locator (URL) containing a logical identifier of a callee, the logical identifier contained in the SIP call request.

As conceded by the Office Action, Nelson does not disclose a Session Initiation Protocol (SIP) request. 5/4/2005 Office Action at 10. Therefore, Nelson does not anticipate claim 22. However, the Office Action relied upon Gross as teaching SIP. *Id.* It is respectfully submitted that a *prima facie* case of obviousness cannot be established with respect to claim 22 for at least the reason that no motivation or suggestion existed to combine the teachings of Nelson and Wood. In Nelson, there are three different entities involved in performing the various acts described in Nelson. A *web browser* is provided in a network device (such as computer 24 or 28). *See* Nelson, Figure 1. The *computer 24* running the web browser is able to access an *IP phone 22a* (which includes a web server) to retrieve a web page containing a functional interface

illustrated in Fig. 3 of Nelson. Thus, the computer 24 on which the web browser is located and the IP phone 22a are separate devices. In response to user selection of buttons in the functional interface of Figure 3, the web browser sends data indicating the user's selection to the IP phone 22a. Nelson, 7:66-8:3. In turn, the IP phone 22a relays a signal to a *call manager 26* to indicate a function to be performed. Nelson, 8:4-9. Once call manager 26 receives the signal, the call manager executes the desired functionality, including placing a call to another phone. Nelson, 8:12-18.

In Nelson, in response to user selection of elements of the web browser presented by a network device, the web browser sends data indicating the user's selection to the IP phone 22a. Nelson, 7:66-8:3. The user can dial individual keys of a keypad 102 or the user may push a speed dial button 104 in the functional interface 100. Nelson, 7:38-41. Thus, what is sent from the web browser to the IP phone 22a are individual pieces of data to indicate what was pressed by the user, either a single number corresponding to a keypad press, or a speed dial button. Interaction between the computer 24 and the IP phone 22a is accomplished with HTTP messages so that actuation of buttons, such as keypad buttons and speed dial buttons, can be communicated from the web browser to the IP phone 22a. Nelson, 8:16-47. There is absolutely no need or desirability to modify the web browser of Nelson to support generation of SIP messages, as the web browser is intended to only provide HTTP messages corresponding to button activations in the functional display to the IP phone 22a. In fact, the IP phone 22a itself cannot establish calls over a data network, and must rely upon the call manager 26 of Nelson. The call manager 26 of Nelson does not contain a display or a hyperlink presentable in the display.

In fact, substituting a SIP request in place of the HTTP request between the web browser and IP phone 22a of Nelson would render the system of Nelson inoperative for its intended purpose. Exchanging SIP between the web browser and IP phone 22a means that it would be desirable to establish a call between the web browser and IP phone 22a of Nelson, which is clearly not the intent of Nelson. In Nelson, the call is established between the IP phone 22a and a remote device, based on a call request issued by yet another entity, the call manager 26. The proposed modification of Nelson based on the teachings of Gross would render the Nelson system inoperative, a clear indication that no suggestion or motivation existed to combine Nelson and Gross.

Independent claims 14, 29, 30, and 35 are allowable over Nelson for similar reasons as for claim 22.

Independent claim 6 was rejected as being obvious over Nelson and Rainis.[2] 5/4/2005 Office Action at 8. To establish a *prima facie* case of obviousness, one of the requirements is that the references when combined must teach or suggest *all* elements of the claim. *See* MPEP § 2143, at 2100-129. Here, that requirement clearly has not been satisfied by the hypothetical combination of Nelson and Rainis. As conceded by the Office Action, Nelson fails to disclose both the accessing and providing acts of claim 6. 5/4/2005 Office Action at 8. Reliance was made on Rainis as teaching the missing elements. *Id.*

Claim 6 recites accessing rules information to determine further information to add to the logical identifier, and providing charge information for a toll call appended to the logical identifier based on accessing the rules information. In contrast, Rainis describes a user selecting an available payment mechanism, such as a basic payment model (in which a user can choose between prepayment using either electronic cash or credit cards), or a secure payment model (in which the user may choose between tokens representing either digital cash or credit card). Rainis, 5:1-11. Thus, the charge information generated in Rainis is based on *user selection*, not accessing rules information as recited in claim 6.

Because the hypothetical combination of Nelson and Rainis fails to disclose or suggest all elements of claim 6, a *prima facie* case of obviousness has not been established with respect to claim 6.

Independent claim 19 was also rejected over the asserted combination of Nelson and Rainis. It is respectfully submitted that a *prima facie* case of obviousness has also not been established with respect to claim 19. As conceded by the Office Action, Nelson fails to disclose a controller to access call rules to determine how a call request is to be generated, and to *add* charge information *to a call request* based on the call rules. It is also respectfully submitted that Rainis also fails to disclose the recited subject matter. Rainis discusses client software providing a telephony server with payment information for a phone call. Rainis, 6:38-59. However,

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[2] The rejection of claim 6 referred to "(if applicable) Wood." However, it is unclear to Applicant what relevance Wood has to claim 6, and the Office Action did not provide any explanation regarding how Wood is applicable to claim 6. Therefore, Applicant is treating the rejection of claim 6 as being over Nelson and Rainis.

nowhere within Rainis is there any indication that charge information is *added to a call request* based on call rules.

Therefore, even if Nelson and Rainis can be properly combined, the hypothetical combination of Nelson and Rainis does not teach or suggest all elements of claim 19, which is a requirement of a *prima facie* case of obviousness.

With respect to independent claim 8, the Office Action has failed to establish a *prima facie* case of obviousness, since there existed no motivation or suggestion to combine the teachings of Nelson and Donovan.[3] As conceded by the Office Action, Nelson fails to disclose a uniform resource locator that contains a telephone number. 5/4/2005 Office Action at 13. However, reliance was made on the teachings of Donovan, specifically to Donovan at column 3, lines 45-60. *Id.* The cited column 3 passage of Donovan refers to URLs used in SIP (Session Initiation Protocol) messages, such as the SIP Invite message. SIP messaging is used by clients to establish call sessions over an IP network.

The device in Nelson that displays hyperlinks selectable by a user is the computer (24 or 28) on which the web browser resides. However, there is absolutely no suggestion anywhere in Nelson of any desirability of employing SIP URLs in the computer 24 or 28 of Nelson. In fact, as specifically taught by Nelson, the computer running the web browser provides HTTP messages corresponding to user selection of buttons of a functional interface to the IP phone 22a. The web browser of Nelson is not capable of establishing call sessions over a data network—that capability specifically rests with the call manager 26. Providing SIP URLs in HTTP messages exchanged between the web browser and IP phone 22a of Nelson would be meaningless and would likely render the web browser and IP phone 22a inoperative for their intended purpose. SIP URLs are used only in SIP messages, and SIP messages are used for directly establishing call sessions over a data network. SIP messages cannot carry key stroke information relating to activation of keys on the web browser as described in Nelson. Therefore, in view of the foregoing, there can be no motivation or suggestion to modify the teachings of Nelson to incorporate the SIP URLs described in Donovan.

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[3] The Office Action mentioned "(if applicable) Wood" and "(if applicable) Gross" in the introduction to the rejection of claim 8. However, in the explanation providing the rationale for rejecting claim 8, the Office Action mentioned only Nelson and Donovan.

A *prima facie* case of obviousness with respect to claim 8 has thus not been established.

Dependent claims are allowable for at least the same reasons as corresponding independent claims. The obviousness rejections of dependent claims 4, 12, and 39 (which depend from claim 33) have been overcome in view of the allowability of claim 33.

In view of the defective application of Nelson and Gross to base claim 14, it is respectfully submitted that the obviousness rejections of claims 15-17, 20, and 21 (which depend from claim 14 directly or indirectly) are also defective.

With respect to claim 23, which depends from claim 22, it is respectfully submitted that the obviousness rejection of claim 23 over Nelson and Donovan is defective in view of the allowability of claim 22.

The obviousness rejection of dependent claim 32 (which depends from claim 30) has been overcome in view of the allowability of base claim 30. The obviousness rejection of claim 40 (which depends from claim 8) has been overcome in view of the allowability of claim 8. The obviousness rejection of dependent claim 41 is defective in view of the defective rejection of independent claim 19.

In view of the foregoing, allowance of all claims is requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (12825RRUS01U).

Respectfully submitted,

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Dan C. Hu
Registration No. 40,025
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, TX 77024
Telephone: (713) 468-8880
Facsimile: (713) 468-8883